

REMARKS

Status of the Claims

In accordance with the foregoing, the claims have been amended. Claims 1-9 and 11-33 are pending and under consideration. Respectfully, the rejection is traversed.

Entry of Response Under 37 C.F.R. §1.116

Applicants request entry of this Rule 116 Response and Request for Reconsideration because the amendments were not earlier presented because the Applicants believed in good faith that the cited prior art did not disclose the present invention as previously claimed.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

Claim rejection under 35 USC § 112

Claims 2-9 stand rejected under 35 USC § 112, first paragraph, and claims 2, 11 and 15 stand rejected under 35 USC § 112, second paragraph. It is respectfully submitted that the amended claims comply with 35 USC § 112.

Claim Rejections under 35 USC § 103

Claims 1-3, 26, 27, 29 and 31-33 stand rejected under 35 USC § 103(a) as being unpatentable over the ATLAS ATM website, as retrieved from the Wayback Machine (www.archive.org) from April 21, 2001, in view of Chen et al. (6, 195,694).

Claim 1 recites:

An automated transaction machine (ATM) placement fee determination method **for determining an ATM placement fee to be paid to a fee recipient entity** in a nonbank location in which an ATM is installed under a payment-by-results contract with a service provider, comprising:

- (a) obtaining electronic history information of the ATM; and
- (b) determining the ATM placement fee, which is to be paid to the fee recipient entity, in a computer-implemented way based on said obtained electronic history information;

said electronic history information including a **beneficial browsing history containing browsing at least one web contents that provide benefits to a financial institution, as the service provider, on the internet, as a result of browsing the at least one web contents, as the ATM has been used by an individual customer,**

wherein the beneficial browsing accompanies a payment by a customer for a transaction on each of the web contents with a credit card issued by the financial institution that installed the ATM (emphasis added).

Atlas relates to operating an ATM in a nonbank site and sending a commissions check as long as the ATM location handles 250 or more transactions per month. Atlas does not teach or suggest that the electronic history information is a browsing history containing browsing web contents that provide informational benefits to the service provider on the Internet as the ATM has been used by an individual customer.

Chen relates to a server system that is connected to one or more networks and has at least one application file or configuration set that the server serves from one or more kiosks on the network. The selection functions 105A, and other information displayed, can be a source of revenue for the owner or operator of the kiosk. Notices provided by the kiosk can be advertisements made for a fee. The amount of the fee might be based on the location of the kiosk, the position/location of the selection function/information on the kiosk, the size of the selection function 105A, and the time and duration that the selection function 105A/information is provided by the kiosk.

Both Atlas and Chen fail to teach or suggest **"browsing at least one web contents that provide benefits to a financial institution, as the service provider ... wherein the beneficial browsing accompanies a payment by a customer for a transaction on each of the web contents with a credit card issued by the financial institution that installed the ATM (emphasis added).**

Atlas merely relates to the information posted on the website of the Atlas Co. placed in the stores and that the amount of money supplied by Atlas varies depending on the number of transactions in the ATM as "Example ATM plan" in "Getting Started."

Further, Chen merely discloses that the amount of the fee of the information displayed merely as an advertisement on the selection functions 105A depends on the time and duration that the selection function 105A/information is provided.

Accordingly, claim 1 is not taught or suggested by Atlas and Chen, alone or in combination, and patentably distinguishes over the cited art. Claims 2-3 and 26 depend from claim 1 and include all of the features of that claim, plus additional features. For at least the reasons stated above, claims 2-3 and 26 patentably distinguish over the cited art.

Claim 27 recites:

a history information obtaining unit for obtaining electronic history information of said ATM, wherein said electronic history information includes a beneficial browsing history containing at least one browsing web contents that provide benefits to a financial institution, the service provider, on the Internet, as a result of browsing the at least one web contents, as the ATM has been used by individual customers ...

wherein the beneficial browsing accompanies a payment by a customer for a transaction on each of the web contents with a credit card issued by the financial institution that installed the ATM.

For at least the reasons stated above, claim 27 is not taught or suggested by Atlas and Chen, alone or in combination, and patentably distinguishes over the cited art

Claim 29 recites:

a history information obtaining unit for obtaining electronic history information of said AFTM, wherein said electronic history information includes a beneficial browsing history containing at least one browsing web contents that provide beneficial information to a financial institution, the service provider, on the Internet, as a result of browsing the at least one web contents, as the AFTM has been used by an individual customer ...

wherein the beneficial browsing accompanies a payment by a customer for a transaction on each of the web contents with a credit card issued by the financial institution that installed the AFTM.

For at least the reasons stated above, claim 29 is not taught or suggested by Atlas and Chen, alone or in combination, and patentably distinguishes over the cited art.

Claim 31 recites "a history information obtaining unit for obtaining electronic history information of said ATM including beneficial browsing that provides benefits to a financial institution as the service provider on the internet as a result of browsing at least one web contents ... wherein the beneficial browsing accompanies a payment by a customer for a transaction on each of the web contents with a credit card issued by the financial institution that installed the ATM."

For at least the reasons stated above, claim 31 is not taught or suggested by Atlas and Chen, alone or in combination, and patentably distinguishes over the cited art.

Claim 32 recites "a history information obtaining unit for obtaining electronic history information of said AFTM including beneficial browsing that provides benefits to the financial institution on the internet as a result of browsing at least one web contents ...wherein the beneficial browsing accompanies a payment by a customer for a transaction on each of the web contents with a credit card issued by the financial institution that installed the AFTM."

For at least the reasons stated above, claim 32 is not taught or suggested by Atlas and Chen, alone or in combination, and patentably distinguishes over the cited art.

Claim 33 recites "wherein said electronic history information includes a beneficial browsing history containing browsing at least one web contents that provide benefits to the a financial institution as the service provider on the internet as a result of browsing the at least one web contents as the ATM has been used by an individual customer, and the beneficial browsing accompanies a payment by a customer for a transaction on each of the web contents with a credit card issued by the financial institution that installed the ATM."

For at least the reasons stated above, claim 33 is not taught or suggested by Atlas and Chen, alone or in combination, and patentably distinguishes over the cited art.

Claims 4-9, 11-19, 28 and 30 stand rejected under 35 USC 103(a) as being unpatentable over Atlas and Chen in view of Steinmetz (6,672,505).

Steinmetz relates to an automated banking machine configuration system and method where an ATM license authority communicates with an ATM through a communications network.

Claims 4-9 and 11-19 depend from claim 1, claim 28 depends from claim 27, and claim 30 depends from claim 29. Claims 4-9, 11-19, 28 and 30 include all of the features of the respective claim they depend from, plus additional features. For at least the reasons stated above, claims 4-9, 11-19, 28 and 30 patentably distinguish over the cited art.

Conclusion

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

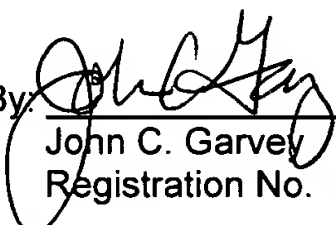
Respectfully submitted,

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10-24-08

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